

### REMARKS

Claims 1-19 were pending in the application. Claims 1-19 have been cancelled without prejudice to presentation in future related applications. New claims 20-38 have been added.

Support for new claims 20-38 can be found throughout the application as originally filed, including, for example, in the as-filed claims, Table 108, page 2, lines 27-38; page 3, lines 29-33; page 12, lines 26-34; page 32, and line 15 to page 33, line 7.

No new matter has been added.

Upon entry of this amendment, claims 20-38 will be pending.

### Preliminary Matters

Applicants wish to thank the Examiner for the helpful suggestions made during a teleconference with the undersigned on June 28, 2006 regarding the grouping of sequences in the Restriction Requirement.

### Restriction Requirement

Claims 1-19 are subject to a restriction requirement. The Examiner required Applicants to specifically identify "either: (a) any one of the sequences identified as SEQ ID NOS:1-952 set forth in Table 1 or Table 2; (b) any one of the mouse sequences (genomic, mRNA, and coding) set forth in Tables 3-112; or (c) any one of the human sequences (genomic, mRNA and coding) set forth in Tables 3-112" in the event that any of Groups 5882-7057 are elected. (Office Action at page 5). Applicants respectfully traverse on the grounds that searching more than one of the groups set forth by the Office would pose no serious burden on the Examiner.

MPEP §803 sets forth criteria for determining when restriction is proper, stating, *inter alia*, that "[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." Applicant respectfully asserts that searching more than group, in particular, Groups 7057 and Groups 2353-3528, to the extent that Groups 2353-3528 pertain to the same gene and organism, would not constitute a serious burden. Applicants note

that with respect to the same gene and organism, Groups 7057 and Groups 2353-3528 relate to the expression of a specific gene and that the same field of search is appropriate for each invention. Accordingly, search results for Group 7057 would be highly relevant to Groups 2353-3528, to the extent that Groups 2353-3528 pertain to the same gene and organism as Group 7057, and *vice versa*.

Although Applicants respectfully traverse the restriction requirement on the grounds that examining more than one invention would not constitute a serious burden, Applicants provisionally elect herein Group 7057 drawn to a "method for diagnosing carcinoma, said method comprising determining the expression of one or more genes ... classified in class 424, subclass 6". New claims 20-35 read on Group 7057. Applicants further elect the human PPP3CC sequences set forth in Table 108. Applicants note that the human PPP3CC sequences in Table 108 include SEQ ID NOS:1586 (human genomic sequence), 1587 (human mRNA sequence) and 1588 (human coding sequence) as set forth on page 204 of the preliminary amendment filed July 22, 2002.

Notwithstanding, as discussed above, Applicants respectfully request that Groups 2353-3528, to the extent that Groups 2353-3528 pertain to human PPP3CC sequences, be examined along with Group 7057. New claims 36-38 read on Groups 2353-3528 and recite human PPP3CC sequences.

Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

#### **Change of Correspondence Address**

Applicants filed herewith a request for Change of Correspondence Address. Applicants note that several previous Requests for Change of Correspondence Address have been filed but to date, have not been effective in updating correspondence address for the current application. Applicants further note that a Power of Attorney with Revocation and Statement Under 37 CFR 3.73(b) was previously filed on September 23, 2005. Please direct future communications relating to the present application to the address associated with Customer Number 55255.

23698.001; 20366-027001  
SERIAL NO.: 10/035,832

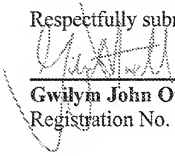
PATENT  
FILED: December 26, 2001

**Conclusion**

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

Please apply any charges or credits to Deposit Account No. 061050.

Respectfully submitted,



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